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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,086	03/05/2002	Jorg Tillack	Mo-6924/LeA 33,697	1660

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/048,086

Applicant(s)

TILLACK ET AL.

Examiner

Robert Sellers

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 13-32.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Robert Sellers
Primary Examiner
Art Unit: 1712

1. The 37 CFR 1.131 affidavit attempts to antedate Schmalstieg et al. by relying on the German priority application no. 199 35 325.5 publication date of July 28, 1999 which falls before the alleged earliest publication date of October 20, 1999 for U.S. Patent No. 6,060,574 to Schmalstieg et al. based on equivalent European Patent No. 950,675. However, the effective date of Schmalstieg et al. is the filing date of April 7, 1999 which is before the foreign priority date of the application of July 28, 1999.

2. According to 37 CFR 1.131(a), "[t]he effective date of a U.S. patent . . . is the earlier of its publication date or **date that it is effective as a reference under 35 U.S.C. 102(e)**. 35 U.S.C. 102(e) states that the effective date is based on "(2) a patent granted on an application for patent by another **filed** in the United States before the invention by the applicant for patent [emphasis added]." Thus, the filing date for Schmalstieg et al. of April 7, 1999 antedates the foreign priority date of the instant application of July 28, 1999 and remains an applicable reference.

3. Schmalstieg et al. (col. 5, line 15) designates amidines as a preferred species of catalyst. Only three types of amidine catalysts are described in column 5, lines 22-43, i.e. open-chain amidines, cyclic amidines such as the 2,3-dimethyl-3,4,5,6-tetrahydropyrimidine of Groegler et al., and bicyclic amidines. The use of a particular cyclic amidine catalyst from among three possible types hardly constitutes a laundry list. It would have been obvious to employ the 2,3-dimethyl-3,4,5,6-tetrahydropyrimidine of Groegler et al. as the preferred amidine catalyst of Schmalstieg et al. in order to reduce the reaction time and/or temperature.

4. Groegler et al. shows 2,3-dimethyl-3,4,5,6-tetrahydropyrimidine in Example 2 (col. 7, line 5), Example 12 (col. 7, lines 58-59) and Example 13 (col. 7, line 67).

The utilization of a particularly preferred alkyl-substituted amidine of Schmalstieg et al. (col. 5, lines 16-18) wherein the claimed species is exemplified no less than three times in Groegler et al. (a reference specifically named in Schmalstieg et al. at column 5, line 30) clearly provides an impetus to employ 2,3-dimethyl-3,4,5,6-tetrahydropyrimidine as the particularly preferred alkyl-substituted amidine of Schmalstieg et al.

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